

REMARKS

Claims 1, 18, and 26-46 are pending in this application.

The Office Action dated April 6, 2005, has been received and carefully reviewed. Each issue raised in that Office Action is addressed below.

ALLOWED CLAIMS

Claims 1, 18 and 44 are indicated to be allowed.

CLAIMS OBJECTIONS

Claims 36, 37, 42 and 43 are indicated to be allowable if amended to include the limitations of their base claims. As argued below, it is believed that all pending independent claims are allowable, and therefore the above claims are not being amended at this time.

FORMAL REJECTIONS

Claims 26-31 and 45 are rejected under 35 U.S.C. 112, second paragraph for being indefinite. By the above amendment, claim 26 has been amended solely to address this indefiniteness issue. The entry of the above amendment is respectfully requested to place the claim either in condition for allowance or in better form for appeal.

REJECTIONS UNDER 35 U.S.C. 102(b)

Claim 26

Claim 26 stands rejected under 35 U.S.C. §102(b) as being anticipated by Nozaki. Claim 26 requires a door glass run that includes a first lip having a proximal end connected to a first leg end

portion, a distal end portion, and a center portion between the distal end portion and the proximal end. A portion of the first leg defines a protrusion having an arcuate first-lip engaging surface. The center portion of the first lip contacts the first lip engaging surface at a first point, and the center portion of the first lip contacts the door glass at a second point spaced from the first point. The second point is further from the end portion than is the first point. The claim defines the structure of a door glass run without respect to the particular door glass used. However, it is respectfully submitted that neither the door glass shown in Nozaki nor a thicker or thinner door glass would make Nozaki satisfy the limitations of claim 26. Nozaki does not show a door glass run having the structure required by claim 26, and claim 26 is therefore submitted to be allowable over Nozaki.

Claims 27, 28 and 45 depend from claim 26 and are submitted to be allowable for at least the same reasons as claim 26.

#### Claim 38

Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto. Claim 38 requires a door glass run wherein a portion of a first leg defines a protrusion having an arcuate first-lip engaging surface. As shown by the enclosed definition of “define,” something that defines must “delineate the outline or form of” something. Leg 58B of Okomoto does not delineate the outline or form of a protrusion – in Okomoto, one lip-engaging surface is defined by insert 62. Leg 58B itself has a flat surface contacting the insert. Because Okomoto does not show a door glass run as required by claim 38, it is respectfully submitted that claim 38 is allowable over Okomoto.

REJECTIONS UNDER 35 U.S.C. 103(a)Claim 32

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki in view of Okomoto. Claim 32 requires a protrusion on a first leg that is formed from the same material as the first leg. The Office Action indicates that Nozaki is “silent” concerning whether the material of element 46 is the same as the material of element 42. While the text of Nozaki may not specifically describe these respective materials, it is respectfully submitted that the stippling of element 46 and the lining of element 42 make it clear that these elements are formed of different materials. The Office Action then asserts that it would have been obvious to make element 46 from the same material as element 42 to “reduce the manufacturing cost” of the door glass run.

First, Nozaki discloses two door glass runs – a “prior art” door glass run in Figure 3 that includes element 46 formed from a different material than the door glass run lips and a door glass run in Figure 1 that constitutes his invention. The fact that the Figure 1 door glass run includes an element 1A made from the same material as the door glass run lips provides no suggestion that structurally different element 46 from the prior art door glass run of Figure 3 should be made in the same manner.

Secondly, it is noted that if a “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP 2143.01 quoting *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). It appears that element 46 in Figure 3 of Nozaki must be compressible because the gap between element 46 and lip 44 is smaller than the thickness of the door glass. If element 46 were formed of the same material as lip 44 it appears that the door glass would not extend properly into the door glass run. For this reason as well, it is submitted that a proper motivation for modifying

Nozaki has not been provided. Claim 32, and its dependent claims 33-37 are submitted to patentably distinguish over Nozaki for at least these reasons.

#### Claim 38

Claim 38 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki in view of Okomoto. It is respectfully submitted that the structurally different insert of Okomoto in no manner suggests moving element 46 of Nozaki. According to the Office Action, this modification would “further prevent rattling by increasing the flexibility of the lip.” No support in the art is provided to show that such modification would either 1) further prevent rattling or 2) increase the flexibility of the lip. Because no proper motivation has been provided for modifying Nozaki as done in the Office Action, it is respectfully submitted that claim 38, and its dependent claims 39-43 and 46 patentably distinguish over Nozaki in view of Okomoto.

#### Claim 29, 35 and 41

Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki in view of Dover. Claim 29 depends from claim 26. It is respectfully submitted that Dover does not address the shortcomings of Nozaki discussed above in connection with claim 26. It is therefore respectfully submitted that claim 29 is allowable for the same reasons as claim 26. In addition, it is respectfully submitted that the fact Dover includes a notch does not provide motivation for adding a notch to Nozaki. Even if such a notch would “increase the ease with which the first lip can pivot with respect to the first leg,” there is no suggestion that it would be desirable to increase the flexibility of the lips in Nozaki – this could, for example, lead to excessive rattling. No motivation has been provided for modifying Nozaki as suggested by the Office Action, and it is respectfully submitted that claim 29

patentably distinguishes over Nozaki in view of Dover.

Claim 35 is rejected as being unpatentable over Nozaki in view of Dover. Claim 35 depends from claim 32 and is submitted to be allowable for the same reasons as claim 32. Claim 35 is submitted to further distinguish over Nozaki in view of Dover for the same reasons provided above in connection with claim 29.

Claim 41 is rejected as being unpatentable over Nozaki in view of Dover. Claim 41 depends from claim 38 and is submitted to be allowable for the same reasons as claim 38. Claim 41 is submitted to further distinguish over Nozaki in view of Dover for the same reasons provided above in connection with claim 29.

#### Conclusion

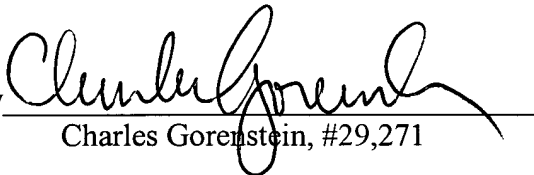
Each issue raised in the Office Action dated April 6, 2005, has been addressed, and it is believed that claims 1, 18 and 26-46 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Charles Gorenstein, #29,271

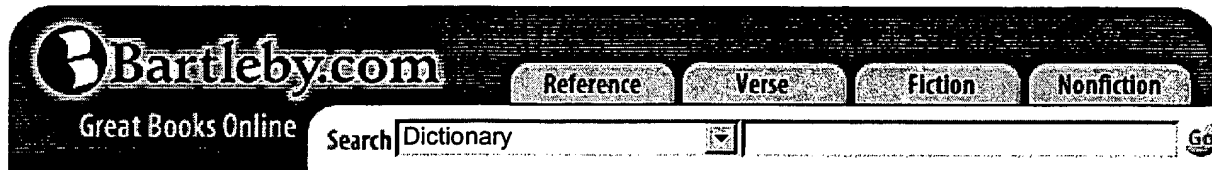
  
CG/STW/pay  
1602-0173P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000



Ads t

Gran  
ups  
Want  
grade  
Engli  
other  
www.



The  
tool  
Gran  
and s  
the e  
white:

Home | Subjects | Titles | Authors | Encyclopedia | Dictionary | Thesaurus | Quotations | English Usage

Reference > American Heritage® > Dictionary

< defile<sup>2</sup>

definiendum >

[CONTENTS](#) · [INDEX](#) · [ILLUSTRATIONS](#) · [BIBLIOGRAPHIC RECORD](#)

The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

## define

SYLLABICATION: de·fine

PRONUNCIATION: dī-fīn'

VERB: Inflected forms: **de·fined**, **de·fin·ing**, **de·fines**

TRANSITIVE VERB: **1a.** To state the precise meaning of (a word or sense of a word, for example). **b.** To describe the nature or basic qualities of; explain: *define the properties of a new drug; a study that defines people according to their median incomes.* **2a.** To delineate the outline or form of: *gentle hills that were defined against the sky.* **b.** To specify distinctly: *define the weapons to be used in limited warfare.* **3.** To give form or meaning to: *"For him, a life is defined by action" (Jay Parini, Boston Globe Magazine Oct. 1, 1990).*

INTRANSITIVE VERB: To make or write a definition.

ETYMOLOGY: Middle English *definen*, *diffinen*, from Old French *definir*, *diffiner*, from Latin *dēfīnīre*, to limit, determine : *dē-*, intensive pref.; see *de-* + *fīnis*, boundary, limit.

OTHER FORMS:  
**de·fin' a·bil'i·ty** —NOUN  
**de·fin' a·ble** —ADJECTIVE  
**de·fin' a·bly** —ADVERB  
**de·fine'ment** —NOUN  
**de·fin'er** —NOUN

ONC